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MOORE & VAN ALLEN PLLC			LAYNO, BENJAMIN	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/708,033  
Filing Date: February 04, 2004  
Appellant(s): ROSE ET AL.

**MAILED**  
**MAR 14 2006**  
**Group 3700**

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Jennifer L. Skord  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/17/05 appealing from the Office action  
mailed 03/16/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1-11 under 35 U.S.C. 101 has been withdrawn.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,417,432	DWYER	05-1995
5,547,199	CALHOUN	08-1996
4,637,799	BOUCHAL	01-1987

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dwyer.

The patent to Dwyer discloses playing cards divided into a first suit having 26 cards, and a second suit having 26 cards. Each card of the first suit has a legend of a letter of the alphabet "A" – "Z" and a picture. Each card of the second suit also has a legend of a letter of the alphabet "A" – "Z" and a picture, see abstract. The first suit and second suit are distinct according to variance in color of border design, col. 5, lines 56-59 and col. 8, lines 51-55. The playing cards also comprise "wild" cards, col. 6, lines 22-23.

In regard to claims 3-7 and 11, the only difference between the legends and pictures on the cards of the claimed invention, and the legends and pictures on Dwyer's cards resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

Furthermore, in *Gulack*, the Court concluded that the claimed printed matter should be given patentable weight because there was a functional relationship between the printed matter and the substrate, in that the printed matter was an endless sequence of digits and the substrate was an endless band, such that the band "presented the digits as an endless sequence with no discrete beginning or end." *Gulack*, 703 F.d. at 1382, 217 USPQ2d at 402. By contrast, in the present case, there is no functional relationship between the substrate (Applicant's cards) and the matter in question (Applicant's legends and pictures) printed on it. The Applicant's cards merely serves the same purpose as the Dwyer's cards, namely, both the Applicant's cards and Dwyer's cards provide a substrate or support for the legends and pictures such that the legends and pictures can be displayed for the convenience of the players. Therefore,

the Applicant's legends and pictures recited in claims 3-7 and 11 do not patentably distinguish from Dwyer's legends and pictures proposed by the Examiner.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun in view of Bouchal.

The patent to Calhoun discloses a method of playing a card game comprising providing a deck having a first suit (sentence cards) 10 and a second suit (picture cards) 14. The first suit and second suit area separated from each other. To play Calhoun's game, a player selects a sentence card from the first suit, and selects at least one picture card from the second suit, col. 5, lines 56-58. The player then must explain to the opposing players how the pictorial elements 16 on the selected picture card 14 relate to the words that make up the sentences 12 on the selected sentence card 10. A time keeper 26 is used to place a time restriction on the player's explanation. Then the other players judge the player's explanation by giving a score from zero points to a selected number of points, col. 7, lines 26-39, see Fig. 7. Play continues with another player until all cards have been selected.

The patent to Bouchal teaches that it is known in card games for players to observe the legends and pictures on displayed cards, and use the legends and pictures

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to tell a story. In view of such teaching, it would have been obvious modify Calhoun's rules, wherein instead of providing an explanation of how a picture card relates to a sentence cards, the player would have told a story based on the pictures on the picture card and the sentences on the sentence card. This modification would have helped players in their storytelling skills.

In regard to claims 13, 17-20, the Applicant is referred to the *Ex parte Breslow* and *Gulack* decisions above.

#### **(10) Response to Argument**

***Discussion of the rejection of claims 1-11 under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,417,432 to Dwyer.***

The Appellants have argued that the Appellants' claimed invention "requires that the playing cards comprise two DISTINCT suits where the first suit comprises threat cards and the second suit comprises tool cards". While in Dwyer, the Appellants have argued that "the letter/picture of each of the 26 cards in the first suit is the same letter/picture of each of the 26 cards in the second suit. Thus, the two suits are the SAME, with the ONLY difference between the two suits being the color of the border design".

The Appellants have also argued that the Examiner has misinterpreted *Ex parte Breslow* which involved a claimed combination card game/board game, where the prior art Mitchell patent also involved a combination card game/board game. The Appellants' summarized *Ex parte Breslow* by indicating that the function between the cards and the

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board in the Mitchell game was the same as the function between the cards and the board in Breslow's claimed game. In contrast, the Appellants' playing cards have significant structural differences in that the cards have *two different suits*, where the first suit has the structure of threat cards and the second suit has the structure of tool cards. However in Dwyer, there are two suits, but the cards of the first suit are the same as the cards of the second suit, with only a minor variance in border color. Thus, the function between Appellants' first suit and second suit is different from the function between Dwyer's first suit and second suit.

The Examiner takes the position that the Appellants' arguments are based on how the Appellants define a suit, and how the Appellant's interpret the printed matter on the cards to distinguish the first suit from the second suit. In the Appellant's claimed invention a suit is defined by legends printed on the cards **and what message these legends convey**. In this case, legends in the Appellants' cards of the first suit **convey the message** of "threat", while the legends in the Appellants' cards of the second suit **convey the message** of "tool". While in Dwyer, a suit is defined by the variance in color of border design. The color of the border design in the cards of Dwyer's first suit **conveys the message** that these cards belong in a first suit, while the color of the border design in the cards of Dwyer's second suit **conveys the message** that these cards belong in a second suit, see Figs. 6A – 6C. Thus, the only difference between the Appellants' claimed legends relating to threat cards and tool cards to distinguish the claimed two suits, and Dwyer's variance in color design to distinguish Dwyer's two suits,



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resides in the meaning and information **conveyed by printed matter**. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

***Discussion of the rejection of claims 12-27 under 35 USC §103(a) as being obvious over U.S. Patent No. 5,547,199 to Calhoun, in view of U.S. Patent No. 4,637,799 to Bouchal.***

The Appellants have argued the Calhoun reference individually by stating that Calhoun requires that the sentence on the sentence card and the picture on the picture card are already predetermined to inherently relate to each other. The Examiner cited Calhoun because it teaches several of the steps recited in the claims, not whether the sentence cards and picture cards are predetermined to inherently relate to each other. This is beside the point. Note, there is **no** recitation in claims 12-27 that limit the threat cards and tool cards to be inherently related or unrelated in any way.

Furthermore, the Appellants have also argued the Bouchal reference individually by stating that Bouchal requires that the player arranges a plurality of picture cards in a matrix array that is a logical sequence so that the player can tell a story based on what the arrangement means. In the Appellants' method, there is no arranging of a plurality of picture cards into a matrix. The Examiner cited Bouchel 799' because it teaches that it is known in card games for players to observe the legends and pictures on displayed cards, and use the legends and pictures to tell a story.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant has also argued that "it is impermissible in a 103(a) rejection for the Examiner to ignore certain teachings of a reference, and instead pick and choose only what the Examiner likes from a reference. As the Examiner should be well aware, such ignoring of teachings of a reference amounts to an impermissible hindsight argument.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

#### **(11) Related Proceeding(s) Appendix**

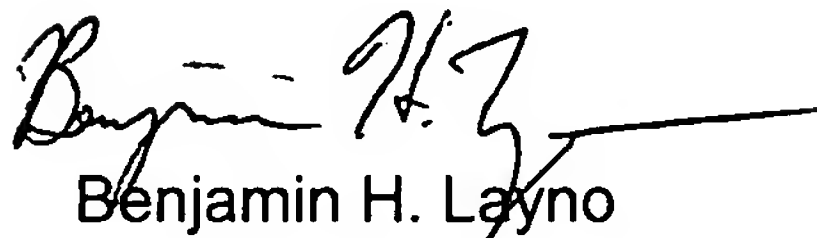
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

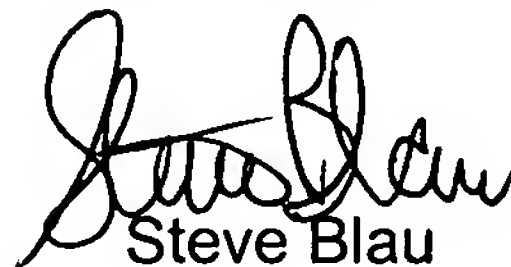
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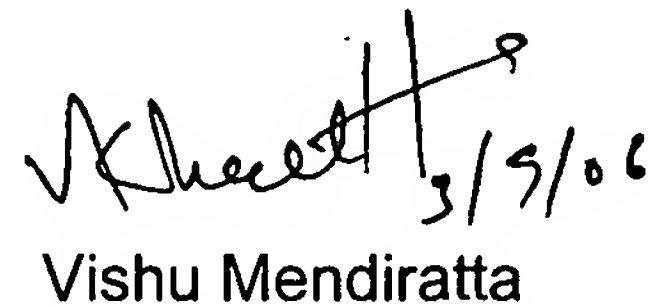
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

  
Benjamin H. Layno

  
Steve Blau

  
Vishu Mendiratta